

REMARKS

This is in response to the Office Action mailed March 5, 2004 and the Advisory Action mailed May 25, 2004. This Amendment supplements the Amendment filed May 5, 2004. Reconsideration of the application, as amended, is respectfully requested.

Applicant has amended claims 1, 6, 7, 12, 17 and 19, and canceled claims 2, 8, 13 and 20. The amendments to withdrawn claims 6, 12 and 19 have generally been made to make them conform to the claims from which they depend. Additionally, claims 2, 8 and 20 (now cancelled) have been substantially rewritten in independent form as claims 1, 7 and 17, respectively. Accordingly, the conducting coil of independent claims 1, 7 and 17 is now described as being "wrapped around the writing pole in a helical fashion".

In the Office Action of March 5, 2004 the dependent claims 2, 8 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tanaka et al. (U.S. Patent No. 6,128,166) in view of Cohen et al. (U.S. Patent No. 5,703,740). The Examiner identified Tanaka et al. as failing to disclose a helical coil arrangement, but found such a coil arrangement to be disclosed in Cohen et al. The Examiner found that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the coil of Tanaka et al. take on a helical arrangement. Additionally, the Examiner found that one would have motivated to make such an adjustment to Tanaka et al. in order to "provide an increased number of turns and to increase efficiency."

In the response of May 5, 2004, Applicant traversed the rejection of claims 2, 8 and 20. Unfortunately, the Advisory Action of May 25, 2004 did not address Applicant's arguments. Accordingly, Applicant submits that independent claims 1, 7 and 17 are non-obvious in view of the cited references for substantially the same reasons as those set forth in Applicant's response of May 25, 2004.

In particular, Applicant disagrees with the Examiner's finding of a motivation or suggestion to combine the references. The Federal Circuit has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983). The Federal Circuit has also found that rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use a claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention, which would be "an illogical and inappropriate process by which to determine patentability." Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). Accordingly, even seemingly simple changes require a finding of a suggestion in the prior art to make the modification to avoid the improper use of hindsight. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Tanaka et al. fail to provide any suggestion of a need for the helical coil arrangement of Cohen et al. or one having an increased number of turns or increased efficiency. Likewise, Cohen et al. fail to provide any suggestion of using the disclosed helical coil arrangement with a writing element that lacks a return pole element. Additionally, there is no evidence that the coil arrangement of Cohen et al. would result in an improvement over that disclosed in Tanaka et al. As a result, the Examiner must rely upon an Applicant's disclosure to provide the suggestion or motivation for the combination and to discern any "obviousness" of the present invention. Such use of hindsight is improper. In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002) ("It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" (quoting W.L. Gore v. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983))).

Accordingly, Applicant submits that independent claims 1, 7 and 17 are non-obvious in view of Tanaka et al. and Cohen et al. Additionally, Applicant submits that all claims depending from independent claims 1, 7 and 17 are allowable as being dependent from allowable base claims.

In view of the above comments and remarks, it is believed that the present application is in condition for allowance. Consideration and favorable action is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to deposit account No. 23-1123.

Respectfully submitted,

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